



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,259	04/29/2005	Yuntae Kim	21186YP	7180
210	7590	05/07/2008	EXAMINER	
MERCK AND CO., INC P O BOX 2000 RAHWAY, NJ 07065-0907			STOCKTON, LAURA LYNNE	
ART UNIT	PAPER NUMBER			
	1626			
MAIL DATE	DELIVERY MODE			
05/07/2008	PAPER			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/533,259	Applicant(s) KIM ET AL.
	Examiner Laura L. Stockton, Ph.D.	Art Unit 1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on April 21, 2008.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,2,5-8,11,12,25-27,32,33,36,37 and 40-42 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 40-42 is/are allowed.

6) Claim(s) 1,2,5-8,11,12,25-27,32,33,36 and 37 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application

6) Other: _____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :July 11, 2005 and July 25, 2007.

DETAILED ACTION

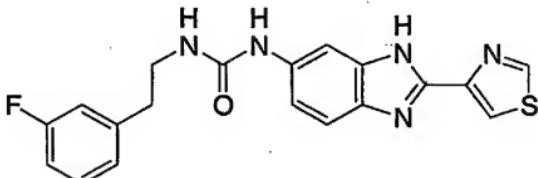
Claims 1, 2, 5-8, 11, 12, 25-27, 32, 33, 36, 37 and 40-42 are pending in the application.

Election/Restrictions

Applicant's election without traverse of Group II {claims 1-9, 11, 12, 25-27, 32, 33, 36, 37 and 40-42 - drawn to compounds of formula (I) wherein R¹ is thiazolyl; and R² is -C(=O)NR⁵R⁶}, and the species of Example 3 found on page 69 of the instant specification (reproduced below), in the reply filed on April 21, 2008 is acknowledged.

EXAMPLE 3

1-[2-(3-Fluoro-phenyl)-ethyl]-3-(2-thiazol-4-yl-3H-benzimidazol-5-yl)-urea (2-77)



2-77

The requirement is still deemed proper and is therefore made FINAL.

Subject matter not embraced by elected Group II is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 21, 2008.

Oath/Declaration

The Declaration fails to comply with 37 CFR 1.497(a) (2) since PCT/US03/34345 filed October 28, 2003 is not identified in the Declaration.

Information Disclosure Statement

The Examiner has considered the Information Disclosure Statements filed on July 11, 2005 and July 25, 2007.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 5-8, 11, 12, 25-27, 32, 33, 36 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, R³ and R⁴ representing an "oxo" group makes claim 1 indefinite because each of R³ and R⁴ are

substituted on an aryl which introduces a valence problem. See claims 2 and 6 for same.

In claim 1, under the definition of R^b , it is unclear what the substituent " $(O)_2R^a$ " represents. See claim 2 for same.

In claim 8, an "and" is needed before " $(C_1-3)perfluoroalkyl$ " for proper Markush language format.

In claims 11, 12, 36 and 37, an "and" is needed before the last compound listed in each of these claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-8, 25, 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by:

- a) Hoff et al. {U.S. Pat. 3,743,738} - see, for instance, Example 57 in column 25; or
- b) Jemison et al. {AU 519,236} - see Compound 20 on page 30, lines 4-5.

Each of the above cited prior art references disclose at least one compound that is embraced by the instant claimed invention. Therefore, each of the cited prior art references anticipate the instant claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5-8, 11, 25, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoff et al. {U.S. Pat. 3,743,738}.

Determination of the scope and content of the prior art (MPEP 52141.01)

Applicant claims benzimidazole compounds. Hoff et al. (see entire document; particularly columns 2-4, 14 and 15; and especially Example 57 in column 25) teach benzimidazole compounds that are either structurally the same as (see above 102 rejection) or structurally similar to the instant claimed compounds.

Ascertainment of the difference between the prior art and the claims
(MPEP §2141.02)

The difference between some of the compounds of the prior art and the compounds instantly claimed is that the instant claimed compounds are generically described in the prior art.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

The indiscriminate selection of "some" among "many" is *prima facie* obvious, In re Lemin, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., anthelmintics).

One skilled in the art would thus be motivated to prepare products embraced by the prior art to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful as anthelmintic agents. The instant claimed

invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

Allowable Subject Matter

The elected species of Example 3, found on page 69 of the instant specification, is allowable over the art of record.

Claims 40-42 are allowed over the art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

/Laura L. Stockton/
Laura L. Stockton, Ph.D.
Primary Examiner, Art Unit 1626
Work Group 1620
Technology Center 1600

May 7, 2008